

ESTTA Tracking number: **ESTTA529637**

Filing date: **03/29/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78811559
Applicant	Seacret International LTD
Applied for Mark	SEACRET
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Submission	Appeal Brief
Attachments	Appeal Brief(Final).pdf (8 pages)(269002 bytes)
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Date	03/29/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Seacret International LTD.
Serial No. 78811559
Filed: February 9, 2006
Mark: Stylized SEACRET

TRADEMARK LAW OFFICE: 113

Trademark Attorney: April A. Hesik

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BRIEF FOR APPELLANT

I. INTRODUCTION

Applicant appeals from the Examining Attorney's final refusal to register Applicant's Stylized SEACRET trademark ("Mark") on the grounds that there is likelihood that the Mark would cause confusion with the registered marks in U.S. Reg. Nos. 3094293, 2855103, 2855101, and 0645874. Applicant respectfully requests the Trademark Trial and Appeal Board ("TTAB") reverse the Examining Attorney's decision and pass the application to publication. Applicant has filed a timely Notice of Appeal. Applicant seeks oral argument in this appeal.

II. POTENTIAL CONFUSION WITH MARK NOS. 3094293, 2855103, 2855101, and 0645874

The Examining Attorney has cited U.S. Registration Nos. 3094293 ("SECRET"), 2855103 (Stylized "SECRET"), 2855101 (Stylized "SECRET") and 0645874 ("SECRET"), asserting that Applicant's mark so resembles those marks that it is likely to cause confusion, to

cause mistake, or to deceive others in the relevant trade or industry. The analysis includes two steps to determine whether there is a likelihood of confusion. First, one must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. Second, one must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely.

Applicant respectfully submits that Applicant's stylized mark "SEACRET" will not cause a likelihood of confusion, mistake or deception relative to the cited marks.

A. Marks Are Dissimilar

In comparing the marks themselves, "[t]he test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result." *Centraz Industries, Inc. v. Spartan Chemical Co., Inc.*, Opp. No. 91159335, 6-7 (TTAB, Jan. 23, 2006). "The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks." *Truescents LLC v. Ride Skin Care, L.L.C.*, Opp. No. 91158556, 15 (TTAB, Nov. 14, 2006). "[I]t is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark." *Id.*

Applicant's mark is a stylized mark with one intentionally dominant feature, the first syllable SEA with a wave design, and is a stylized form mark in drawing code 5. Applicant's stylized mark, with fanciful spelling and a wave design through the first three letters, focuses on the first syllable of the word and will evoke images of the sea in a consumer's mind. Additionally, English speaking consumers will naturally place additional stress and emphasis on

the first part of this stylized mark because of the way it is written. Because consumers will naturally stress a part of a word that is intended to dominate, it will change the way consumers perceive the word to be pronounced. This fact was apparently recognized by the Trademark Office when they allowed the registration for applicant's trademark SEAcet, reg. # 4,147,145.

Further, there is no dictionary meaning that is possible to ascribe to the stylized "Seacet" mark, as it is a suggestive term. However, the initial connotation on seeing the word will be to think of the sea or ocean. Only after the word is pronounced will the play on the meaning of the ordinary word "secret" come into play. Upon examination, the emphasis on the "sea" connotation becomes clearer, as all of Applicant's products contain ingredients from the Dead Sea. Thus, the connotation to a consumer will principally conjure up images of the sea and secondarily conjure a perception of "secret ingredients."

Further, an intended commercial impression is created by the dominant feature of the mark: SEA with the wave design. Though the rest of the mark is intended to make a play on a commonly known word, the overall commercial impression will be dominated by the visual image of the stylized mark, "Seacet" with a wave design. This intentional dominance of the initial part of the mark, plus the stylized wave design changes the overall impression of the mark substantially. As noted above, it is the recollection of the average purchaser, who retains a general impression of trademarks. Given the dominance of the initial three characters in this mark, it is distinctive from Registrant's, as the average purchaser will most likely retain a recollection of the SEA portion of the mark.

Registrant's term "Secret" is not a play on the word SEA and further does not include the wave design in any part of the mark. Visually, it is nothing like Applicant's mark and the overall commercial impression does not lead a consumer to confuse whether "Seacet" with design is the

same any “Secret” mark cited by the Examining Attorney.

In fact, Applicant’s representative performed an internet search of the term “Seacret” (See Exhibit A of Applicant’s Request for Reconsideration After Final Office Action dated December 31, 2012) and a separate search for the term “Secret” (See Exhibit B of Applicant’s Request for Reconsideration After Final Office Action dated December 31, 2012) and discovered that the other was not found in the results of the searches. For clarity, the search for “Seacret” did not result in finding products under the term “Secret,” and in like manner, the search for “Secret” did not result in finding products under the term “Seacret.” Because of the difference in the marks, consumers would not be able locate the other by an internet search and this further provides evidence of the difference in the marks.

B. Goods are Dissimilar

Comparing Applicant’s usage and Registrant’s, the goods are dissimilar. Registrant’s use the marks “SECRET” for “body spray,” “personal deodorant/anti-perspirant,” and “personal deodorant.” In contrast to Applicant’s mark, which identifies “Non-medicated skin care preparations, namely, moisturizers, facial cleansers, facial peels, masks, lotions, creams, scrubs, soaps, nail care preparations, hand creams, cuticle oils, aftershave.” Applicant’s goods do not include “body sprays,” “personal deodorant/anti-perspirant,” or “personal deodorant”, therefore, there is no overlap in goods whatever. In fact, there is no likelihood that Registrant would even bridge the gap to produce non-medicated skin care preparations as defined in Applicant’s identification of goods. Registrant has used the mark “Secret” for deodorant since 1956 and the only expansion was to a similar product with a body spray that is a fragrant body spray. Accordingly, the goods associated with “Secret” are deodorant and now body spray. It is not so broad sweeping to include non-medicated skin care preparations.

The Examining Attorney has performed research in order to show how third parties have provided goods that are both deodorants and skin care preparations and has used this as a basis to indicate that Applicant's goods are related to Registrant's goods. Applicant believes that this it is overreaching to assert that since a third party has been identified that provides deodorants and skin care preparations that we can amend the scope of the goods identified by Registrant. Registrant has registered for specific goods and has not varied from that usage since 1956. Because a third party may provide goods that are both deodorants and skin care preparations, does not then result in consumers being confused between Applicant's mark and Registrant's mark.

Additionally, with regard to relatedness of goods or services, three criteria for testing the relatedness should be employed, which are "First, if the parties compete directly, confusion is likely if the marks are sufficiently similar; second, if the goods and services are somewhat related, but not competitive, then the likelihood of confusion will turn on other factors; finally, if the products are unrelated, confusion is highly unlikely." *See Autozone, Inc. v. Tandy Corp.*, 373 F.3d 786, 797, 71 U.S.P.Q.2d 1385, 2004 Fed.App. 0200P; Lanham Trade-Mark Act, §§ 32(1), 43(a)(1)(A), 15 U.S.C.A. §§ 1114(1), 1125(a)(1)(A). The Applicant and the Registrant do not compete directly because they do not sell competing goods as previously discussed. At best the Examining Attorney has offered evidence that the goods are somewhat related, but not competitive and so this determination turns on other factors. Applicant asserts that while both Applicant and Registrant sell goods through Amazon, a search for the terms of the Registrant's goods, as provided in Exhibit C of Applicant's Request for Reconsideration After Final Office Action dated December 31, 2012, does not yield an indication of Applicant's goods, and a search for terms of Applicant's goods, as provided in Exhibit D of Applicant's Request for

Reconsideration After Final Office Action dated December 31, 2012, does not yield an indication of Registrant's goods providing evidence that there is no likelihood of confusion. Further, a search on Amazon of the mark "Secret" resulted in only products that have "Secret" in them, as shown in Exhibit E of Applicant's Request for Reconsideration After Final Office Action dated December 31, 2012. Additionally, a search on Amazon of "Seacret" resulted in only products displayed offered by Applicant, as shown in Exhibit F of Applicant's Request for Reconsideration After Final Office Action dated December 31, 2012. Again, there is no likelihood of confusion. Consumers are likely to search for products the identification of the product they are looking for or by entering the actual trademark of the product being searched. Neither one of these searches on a website that sells both products places the other goods on the same results page. Accordingly, there is no likelihood of confusion.

Accordingly, the goods are dissimilar and will continue to be dissimilar. This serves as additional evidence that there is no likelihood of confusion.

C. Channels of Trade are Dissimilar

Applicant's and Registrant's goods travel in distinct channels of trade and cannot be found side by side on a retail store counter. Applicant's products are sold mainly through kiosks on a one-to-one basis and they have a different pricing structure than Registrant's products. Applicant's products are directed toward a more sophisticated consumer, since they are much more expensive than Registrant's products. A consumer seeking an expensive non-medicated skin care preparations, namely, moisturizers, facial cleansers, facial peels, masks, lotions, creams, scrubs, soaps, nail care preparations, hand creams, cuticle oils, aftershave would be discriminating and know that they are not purchasing a product coming from a deodorant and body spray manufacturer. This can be seen in the Evidence submitted on with the Office Action

Response dated February 7, 2007.

D. Concurrent Use Without indication of Actual or Likelihood of Confusion

Applicant has been using the Mark in commerce since August of 2005. Applicant's use has been nationwide with substantial sales. In 2005, Applicant operated 120 kiosks with \$5,076,621 in revenue. In 2006, Applicant operated 235 kiosks with \$8,303,136 in revenue. In 2007, Applicant operated 430 kiosks with \$20,751,112 in revenue. In 2008, Applicant operated 400 kiosks with \$13,469,204 in revenue. In 2009, Applicant operated 307 kiosks with \$10,381,004 in revenue. In 2010, Applicant operated 150 kiosks with \$5,870,950 in revenue. In 2011, Applicant operated 151 kiosks with \$6,718,888 in revenue. During this over 7 years of concurrent use, Applicant has not had any indication of actual confusion, and further Applicant has not been made aware from Registrant of any actual confusion. Further, in Opposition No. 91174407 between Registrant and Applicant with regard to Application Serial No. 78598113 mark for SEAcet, the Registrant failed to file a response and the opposition was dismissed with prejudice, whereupon Applicant filed a voluntary amendment on June 8, 2012 at the request of the Examining Attorney. The Examining Attorney responded with a Final Office Action indicating that the dismissal of the opposition was not dispositive of this application under res judicata, collateral estoppel or stare decisis. While Examining Attorney may be correct with regard to res judicata, collateral estoppel or stare decisis, the probative value of Registrant not pursuing an opposition in a highly similar mark is still present. The fact that Registrant did not further pursue the opposition further leads to the conclusion that Registrant did not find the Applicant's marks confusingly similar.

Accordingly, after so many years of concurrent use with no indication of actual confusion and Registrant's decision not to pursue an opposition on the SEAcet mark, there is

significant support for the finding that there is no likelihood of confusion. If the marks and commercial impression were so similar as asserted by the Examining Attorney, it is likely that some indication of confusion would have been made during these last 7 plus years. Yet, there is none because the marks are dissimilar, the goods are dissimilar and the channels of trade are dissimilar. There is no likelihood of confusion as asserted by the Examining Attorney.

III. CONCLUSION

The marks cited by the Examining Attorney are dissimilar, the goods are dissimilar, the channels of commerce are different, Applicant's consumers are sophisticated, and concurrent use for over 7 years has not rendered actual confusion; therefore, Applicant's mark is not likely to cause confusion with the cited marks. Accordingly, the Examining Attorney has not met the burden of proving that Applicant's use of the stylized "SEACRET" mark for its identified services is likely to cause any confusion with the cited marks. For the reasons set forth herein, Applicant submits that its Mark is not confusingly similar to the cited marks and the Examining Attorney's decision should be reversed and Applicant's application passed to publication.

Respectfully submitted,
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Dated: March 29, 2013

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